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IN THE

United States 1298

# Circuit Court of Appeals,

FOR THE NINTH CIRCUIT.

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Pacific States Electric Company,
*Appellant,*

*vs.*

William D. Wright,
*Appellee.*

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## OPENING BRIEF FOR APPELLANT.

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## STATEMENT.

This case is an appeal, duly taken and perfected, from a decree of the United States District Court for the Southern District of California, Southern Division, in the case of William D. Wright v. Pacific States Electric Company. That case was brought for alleged infringement of claims 6, 7, 8 and 9 of United States letters patent to William D. Wright, No. 1,214,486, dated January 30, 1917, for "Electric Cook-

ing Apparatus." The device alleged to infringe said claims is a waffle iron manufactured by Landers, Frary & Clark, of New Britain, Conn. (which has undertaken the defense of this suit), and sold in the Southern District of California by the appellant, Pacific States Electric Company. The case was tried before His Honor, Judge Trippet, in Los Angeles, who filed an opinion [T. R. p. 174] holding said claims valid and infringed, on which the usual interlocutory decree was entered [T. R. p. 178], an injunction and accounting and costs judgment being stayed on filing of a supersedeas bond pending the termination of this appeal.

The assignments of error [T. R. p. 186] are fourteen in number. They may be grouped under three heads, namely, validity, infringement, and relief, assignments 1, 3, 6, 7, 8, 9 and 10 involving validity of the claims, assignments 2 and 4 relating to infringement, and assignments 5, 11, 12 and 13 relating to relief granted, and assignment 14 title or ownership of the patents sued on in the plaintiff-appellee.

As to validity, appellant claims that in view of the prior art the claims are invalid, certainly when given any such breadth of interpretation as shall include defendant's device; that as to infringement the claims in issue are not infringed by defendant's device under any construction of the said claims that will save them from the prior art, and that as to the relief the court erred in not dismissing the bill and in decreeing an injunction, accounting and costs.

Before discussing these principal issues of validity and infringement, it will be helpful to clearly understand the disclosures of the Wright patent and the claims in issue as related to such disclosure, and also to briefly review the art prior to the patent in suit in the light of which art the claims in issue must be construed.

## FIRST.

### The Wright Patent in Suit.

This patent is for an invention relating to improvements in

"Electric Heating Apparatus, more particularly to be used for grilling and waffle baking purposes, but which may also be used for any purpose of the ordinary electrically heated stove and which may be folded up so as to occupy a small space when not in use, and which provides a large surface when unfolded" (p. 1 of the patent, lines 10 to 17).

In carrying out this invention, one of the objects is stated to be

"to provide a new and novel construction of waffle iron" (p. 1, line 23),

and another is to provide

"a device of the kind that may be quickly converted from one use to a different use, as from a waffle iron to a grill, or to a device providing a large heating surface when required" (p. 1, lines 26-30).

The title of the patent is "Electric Cooking Apparatus." Therefore, when the claims in issue, as they all do, begin with the words "In a device of the class described," the combinations of elements are to be so interpreted as to make them adapted for, and operative in, such a device.

As the issue here is against a waffle iron pure and simple, and not an electric cooking apparatus that can be *converted* from the waffle iron to a grill, or *vice versa,* or can be used for general heating purposes, the construction which the specification of the patent discloses in detail for all these purposes need not be here set forth in detail.

It will be sufficient to explain that Fig. 1 shows the general construction of the device, in which figure it will be understood that *a* represents a lower member or *grill* member mounted on legs $z^5$. This member is provided with electric resistance wire for grilling and heating purposes. Mounted on these legs are bent arms represented by *m-m'*. To these is pivotally mounted the lower waffle member *b,* and the mountings are so constructed and arranged that this waffle member can be both moved forward and out of its position above the grill member *a* shown in Fig. 1, and can be rotated or turned upside down so as to bring the waffled surface directly over the heating surface of the lower or grill member. Then there is the upper waffle member *c* and this is not hinged to the casing of the lower waffle member but is attached by hinges that are secured at one end to the upper waffle member

and at the other end to support members $z^7$ attached to the frame of the grill member. By this construction and mode of operation Wright *disconnects* one waffle member from the other except as both are connected to the supports of the lower or grill member, and is enabled to operate the lower waffle member independently of the upper waffle member so as to take it away from its position over the grill member or rotate it above the same. These hinges of the upper waffle member are lettered *"r"* and *"s"*. They are shown in Fig. 1 and also in Figs. 2 and 3, where their attachment to the supports $z^7$ and their lack of connection to the lower waffle member clearly appears.

Thus there is a definitely disclosed reason for this *peculiar independent mounting of the waffle irons* of the apparatus of the Wright patent, and thus is made apparent the proposition that if in the Wright apparatus, as shown, the two waffle members were hinged together, as in defendant's device, *the Wright apparatus would be inoperative* because then the lower waffle member could not be moved independently of the upper waffle member. It could not co-operate with the grill member at all. Thus, also, significance is given to the phrase in all of the claims in issue, "In a device of the class described, a pair of casings pivotally connected together." That is, not merely hinged together as in defendant's device, but with a pivotal connection through the supports of the lower grill member so that the lower waffle member may pivot in the manner described in the specification and herein-

above outlined, and that the upper waffle member may also pivot independently of the lower waffle member on supports of the lower grill member, through which, as above explained, the two waffle members have their peculiar pivotal connection with each other. That these three parts are intended to be thus interrelated is emphasized not only by the full description of the Wright specification, but also by the statement (p. 1, line 48) that

"the principal parts of my invention are the base, or grill member *a*, the lower waffle member *b*, and the upper waffle member *c*."

The mounting of the upper waffle member, which we have described, is set forth in the Wright specification, p. 2, lines 75-78, as follows:

"The member *c* is mounted by means of hinges *r* and *s* which are each mounted at one end on the casing *c'* at $z^8$ and $z^9$ and on the support $z^7$ at $z^{10}$."

The construction of the waffle members themselves is set forth at p. 1, lines 71-83, this description being prefaced by the statement that the waffle members are preferably of aluminum and

"may be of any shape desired"

so that whether the waffle member is rectangular or circular in shape is not of essence to the alleged invention of Wright. The construction of the waffle members, quoting from the reference above made, is set forth as follows:

"The member *b* is composed of an outer hollow casing *n*, which is preferably made of pressed steel,

and is provided with a recess or chamber sufficiently deep to contain the non-conductor $n'$, the heating element $n^2$, the non-conducting element $n^3$, and the base portion of the metallic cooking surface member $n^4$, all in the order in which I have enumerated the same. The metallic cooking surface member $n^4$ is provided on its circumference with a projecting shoulder $n^5$ which rests upon and covers the edge of the casing $n$."

This description obviously sets forth the casing like a box, which box is sufficiently deep to *"contain"* the different elements enumerated, namely, first the non-conducting element, then the electrical resistance or heating element, then some more non-conducting material, and then the base portion of the waffle cooking surface itself. All these parts are fastened together, naturally. The evident intent and belief of the inventor was that his novel construction of waffle member resided in his conception of taking the box-like casing into which, as a box, he placed non-conducting material, electric resistance, heating wire, more non-conducting material, and the waffled cooking surface. Both waffle members are alike in this respect.

Claims 1 to 5, not here in issue, are generally directed to the construction and mode of operation of the lower waffle member with its relation to the grill member. Claims 6, 7, 8 and 9, which are here in issue, are directed more particularly to the waffle members pivotally connected together in pairs, as stated. While these claims may not be limited to the construction which enables one of them to co-operate

with a grill member, still they are to be considered with reference to the device shown and described and the elements of the combinations of these claims are to be understood as elements "in a device of the class described," that is, elements which are directed specifically to the waffle members of the device but which are so constructed and arranged that they will operate as waffle members in the "electric cooking apparatus," which is the subject of the patent. Therefore, when the claims call for casings "pivotally connected together," that language must be considered significant in the light of the specification, and when, as in claim 1, the waffle members are provided with aluminum baking surfaces "mounted *in* each of said casings," and "means mounted *in* said casings * * * for electrically heating said waffle members," the specification only discloses these parts mounted in the casings as though placed in a box and not carried by the bottom of the waffle iron itself; and when, as in claim 7, the aluminum surfaces are mounted in the casings

"so that their surfaces extend **past* the edges of said casings"

the description and drawings show the edges carried past and not flush with the edges of the casing, and when, as in claim 8, the box-shaped casings are connected

"so as to fold one upon the other"

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*Italics in quotations in this brief are ours unless otherwise noted.

and the electrical means are

"mounted in the space between said waffle member and said casing,"

the prior description and drawings of the patents show what that language means, as in claim 9 also the words "electrical means mounted in the space between said waffle member and said casing"

and

"a non-conducting element spacing said electrical heating element from said casing"

again clearly refer to the peculiar box-like container construction and mode of operation which the Wright specification sets forth.

To assume that the inventor *intended* or *even had in mind* any mode of operation other than that described in the patent, or a pivoted connection of the lower and upper waffle members which would render the device pictured and described in the patent inoperative, is doing violence to every known principle of construction of letters patent, which are contracts. And yet to find infringement in the case at bar such objectionable interpretation is necessary.

## SECOND.

### Prior Art.

In general, the art prior to the alleged invention of Wright embraced a wide line of electric cooking apparatus. This is disclosed by sundry patents of

record. Landers, Frary & Clark itself had already, since 1912, put on the market an increasing line of electric cooking apparatus, including percolators, chafing dishes, coffee pots, stoves, grills. [T. R. pp. 37, 45.] Specifically, electric heated waffle irons hinged together had been made and sold by the Simplex Co. for many years prior to the alleged Wright invention. [T. R. pp. 29, 140, 229.] These Simplex waffle irons were shown as Defendant's Exhibit No. 1. Aluminum as a cooking surface was well known generally long prior to the Wright invention and was known specifically for use as a waffle iron

"prior to the earliest date of invention which may be claimed in behalf of the patentee of the patent here in suit." [T. R. p. 66.]

These aluminum waffle irons (Defendant's Exhibit No. 21) were not electrically heated. They did, however, possess all the advantages that aluminum has for a waffle iron, namely, lightness, quick heating, and, at proper temperature, lack of necessity of greasing to keep the cakes from sticking. This last is a relative advantage, because, as Mr. Wright states [T. R. p. 99], this peculiar property of the aluminum exists "at a proper temperature," and, as was stated by counsel to the court [T. R. p. 158],

"Greasing can be dispensed with when using aluminum only unless the heat is just so—if the heat is brought up gradually."

The tag on the old Griswold aluminum waffle iron states that it is not necessary to grease the aluminum griddle to keep the cakes from sticking.

*Crompton British Patent* [T. R. pp. 169-171]: The drawings of this device show more clearly in the exhibit itself than in the reduced reproduction shown in the transcript of record at p. 171. Also, an hiatus appears to be present at the bottom of transcript of record p. 169. The device was primarily for grilling or cooking meat by electricity and for providing the electrically heated surface with a peculiarly corrugated surface for that purpose. These heating surfaces or plates are shown as rectangular in form, although the patentee states that he does not confine his invention

"to any special form of electrically heated plate." [T. R. p. 170.]

The device is shown and described as being capable of use either with one member alone as a grill, or with one electrically heated member provided with a lid, or cover, or with "two directly heated surfaces" which are shown as hinged or pivotally connected. [See Fig. 1, T. R. p. 171, and specification, T. R. p. 170.] The specific construction of each heating member is not set forth in great detail except as to the heated or cooking surfaces, but the drawings are perfectly clear in showing a casing mounted on legs. This casing is shown as rectangular in shape and of box-like construction. Into this box there is placed, as shown, a filling or spacing material, the heating circuits or electrical resistance wire embedded in enamel or "insulating medium," and the corrugated cooking surface itself. This cooking surface has a flange which covers

and rests on the upper edge of the box-like casing and to which it is attached by screws, thus holding all the parts together. The hinge member attached to the lower casing is shown in dotted lines, Fig. 1, and to the upper lid or casing, if one is used, in dotted lines in Fig. 3. As the specification says that in some cases the patentee prefers

"to use two directly heated surfaces, both of which may be formed as above,"

that is, both of which may have the corrugated or roughened surfaces, and both of which are directly heated by electricity, we have in this Crompton patent a complete disclosure in the broad sense of, in an electric cooking apparatus,

"a pair of casings pivotally connected together,"

with the cooking or baking surfaces covering the upper edge of said casing, with the corrugated cooking surfaces supported on the edge of the casing and spaced apart from the bottom thereof, and

"electrical means mounted in the space"

between said "cooking member" and said casing for heating the cooking member, and

"consisting of an electrical heating element adjacent said"

cooking member, and a

"non-conducting element spacing said electrical heating element from said casing."

Except for the fact that the Crompton iron, although corrugated and ridged, is not stated to be specifically

for waffles, although it is for "culinary purposes," and except for the fact that the heated or cooking surfaces are not specifically described as aluminum (in itself, however, old in the art prior to Wright), we have here precisely the electrical cooking apparatus of the Wright patent in suit so far as that patent may be said to apply to defendant's device. It is shown with electrical connections and of a construction and size that adapt it for table use if desired. It shows every alleged inventive conception that can be ascribed to Wright in the way of constructing a waffle member having a box-like casing into which the non-conducting element, the heating element, and the lower portion of the heated or cooking surface is placed or contained. These are shown as furnished with proper supports, as hinged or pivotally connected, as having the edges of the heated or cooking surface extend as a flange to cover the upper edges of the casing, as connected by socket connection with an electrical conductor, and all of a construction and mode of operation substantially as shown in the Wright patent. It is obvious that the mere substitution of aluminum, in view of the prior art, can not impart patentable novelty to Wright. It is not stated in the Crompton patent whether the casings are of cast metal or sheet metal, but that, in view of the art at the time of the Wright patent, would certainly not impart patentable novelty to Wright.

We submit that this Crompton patent alone is a full prior art showing of anything substantial that is

common to both defendant's device and the Wright patent in suit. Neither it nor the Griswold and Simplex uses were discovered by the Patent Office in the examining of the Wright patent application, and it is therefore incumbent upon the court to reopen, as it were, the question of novelty and invention as pertaining to patentability. The presumptive validity of the Wright patent is therefore of but little legal value, if, indeed, of any legal value.

*Lamb Patent No. 1,060,265, April 29, 1913* [Deft.'s Exhibit 13, T. R. p. 254], shows an electrically heated device in which the heated or cooking surface extends over the top of a sheet metal casing to which it is secured. To the bottom of this heated or cooking surface is attached the electric unit with a metal plate, and, with its insulation and wire, in the space between the heated member and the casing, in all senses in which, in defendant's device, such parts may be said to be "between" the heated member and the casing. Substantially this device has been manufactured by Landers, Frary & Clark ever since at or before the date of the said Lamb patent. Substantially this same idea and method of construction has been and is followed by Landers, Frary & Clark in many of its electrically heated cooking utensils, as, for instance, Lamb patent No. 1,060,263, April 29, 1913 [Deft.'s Exhibit 11], also Lamb patent No. 1,060,267, April 29, 1913 [Deft.'s Exhibit 15], Lamb patent No. 1,060,266, April 29, 1913 [Deft.'s Exhibit 14], and others. Defend-

ant's Exhibits Nos. 4, 5, 6, 7, 8, 9, 10 and 16 are physical exhibits showing this general construction.

*Capek Patent No. 493,422, March 14, 1893* [Deft.'s Exhibit No. 22, T. R. p. 266], is clearly an illustration of an electrically heated cooking apparatus pivotally connected together so as to fold one upon the other as in a waffle iron (Fig. 7). Both these Capek parts are provided with electric heaters mounted "between" (in the broad sense) the top of the heated member, which extends over the edge of the casing, and the bottom of the casing and made to fold one upon the other for cooking in between, thus cooking "evenly on both sides at the same time," as the Wright patent puts it. As the Capek patent says (p. 2, line 100), when in the position shown in Fig. 7 the two heaters can be used independently, but when moved to closed position

"the substance being cooked being placed between the two heaters."

A model [Deft.'s Exhibit 17] has been made and put in evidence showing the construction of this Capek patent and with a removable top so that instead of a smooth cooking surface a waffled cooking surface may be substituted. The shape and dimensions are different from the waffle irons in question, but the general construction is substantially the same, and "shape" is no part of the invention of the patent in suit, as that patent expressly states that the waffle members

"may be of *any shape* desired."

*The testimony of Mr. Lamb* for defendant shows that Landers, Frary & Clark

"had begun their work on their waffle iron before you had any knowledge of the Wright patent." [T. R. p. 61.]

"which was made before we knew there was such a patent as the Wright patent." [T. R. p. 59, also T. R. pp. 150-153.]

They simply followed out, in that waffle iron device, the general method of construction of electrical unit, and attachment thereof, of their other considerable line of electric cooking apparatus. The company had been many years engaged in manufacturing household articles (alcohol heated and then electrically heated) and this waffle iron in question was simply an addition to that line of their regular course of development. And in the manufacture of the waffle iron, begun before knowing of the Wright patent, they followed precisely the kind of construction adopted by them long before the alleged invention of the Wright patent.

## THIRD.

### Defendant's Device.

In defendant's device the casing does not constitute a box-like container, in which are laid the insulating materials and the heating wire, as in the construction of the Wright patent. On the contrary, in defendant's structure the construction of Lamb patent No.

1,060,265 is substantially followed, that is, the heating unit instead of being attached to the casing is attached to the bottom of the heated element (in the case at bar to the waffle iron and in the device of the Lamb patent to the stove surface). A metal plate backs the electrical unit and screws passing through this plate into the waffle iron hold all the parts together as a unit. It is then rested on a casing and attached thereto by screws passing through the sides (as in the Crompton British patent). The waffled surface does have out-turned lips that cover but do not project beyond the edge of the casing. This is common construction in many, if not all, the prior art electrically heated utensils of Lamb patents and Capek patent. There is no patentable novelty in the idea anyhow. Generally speaking, and specifically speaking, there is none. The stove of the said Lamb patent had it long prior to the Wright patent, as also did other prior devices of the manufacture of Landers, Frary & Clark, and it is an obvious mechanical expedient.

In brief, defendant's device is a plain, electrically heated waffle iron, not having the dual capacity of the Wright patent in suit, to be used as a grill or for general heating purposes. Defendant's device has none of the parts and functions that go with that dual capacity. It is an electrically heated waffle iron. So was the Simplex waffle iron long prior to Wright, and, in any event, as the Patent Office informed Wright when he was applying for his patent,

"The application to a waffle iron of an electric heater is not considered patentable broadly." [See F. W. & C. of the Wright patent, T. R. p. 294.]

Obviously, this was because it was well known that at the date of the alleged Wright invention the art was well acquainted with the art of heating by electricity and sundry patents and devices had been granted and were on the market for cooking by heat caused by electricity. Therefore, merely to do the cooking in a waffle iron by electricity was evidently no patentable novelty or creative conception at the date of the Wright alleged invention. Besides, the Simplex waffle iron did that specific thing. And, moreover, as we have seen, Wright also offered no novelty to the art or to the trade in the fact of stating or claiming the use of aluminum for the waffled surface. That was old in the Griswold waffle iron, for instance.

In defendant's device also, instead of having "means *mounted in* said casings between said casings and said waffle members for electrically heating said waffle members,"

as called for in the claims in issue, the means for electrically heating the waffle members in defendant's device are not mounted or *contained in* the casings in the sense shown and described in the Wright patent and the waffle iron laid on top of the same *in* the casings as in the Wright patent, but in defendant's device the means for electrically heating the waffle members are attached directly to the bottom of the waffle member itself, with a metal plate clamping the same to

the bottom of the waffle surface, leaving no air space between the electrically heating unit and the waffle iron, and the metal casing acting as a finish or screen or cover for the other parts, and to cover, and prevent, injury from the leading-in electric, conducting wires.

## FOURTH.

### Defendant's Device Does Not Infringe.

Not to repeat at length, it is evident from the foregoing that the claims of the Wright patent must be so limited as not to include defendant's device.

(a) *Those claims must be construed in view of the drawings and specification of the patent in suit.* Those drawings and that specification show means and ways of construction and a mode of operation that are different from the means and ways of construction and mode of operation of defendant's device. In the waffle irons of the Wright patent in suit the casings are the peculiar and dominant features. They are made and operate like metal boxes bottoms down and covers off. Into these metal boxes, as containers, and supports, Wright places in the order he names and from the bottom of the box upward, first, a layer of insulating material, then the wire to be electrically heated, then another layer of insulating material, and then, on top of these, the waffle iron itself with its edges projecting over the edges of the box. That was the Wright con-

ception of the way to make an electrically heated waffle iron, use a box as a box and place in the box the parts enumerated and in the order stated.

In defendant's device that is not the construction and mode of operation. In defendant's device the dominant feature *is the heated or waffled surface itself.* Onto the bottom of this is fastened by a clamping metal plate the insulating material and the wire to be electrically heated. A screen or cover is provided, which does not "contain," in the sense of the Wright patent, the parts, but screens or covers the parts and protects the electric, conducting wires leading in from a lamp socket to the waffle iron. The screen does not *contain in* it the parts. No insulating material is first laid in it to "space" the electric resistance wire from it.

*"Pivotally connected together,"* it will be noticed, and understood, that the Wright patent shows and describes casings, not only *containing* certain elements, but "pivotally connected together" (as the claims put it) in a peculiar manner.

In Wright the lower waffle member has to be so mounted that it can make a slide forward and be lowered to a position in front of the grill member of the device, and then can be raised and turned over so as to lie immediately over the top of the grill member and, with it, aid in cooking any substance placed between the two.

*Wright patent device inoperative if waffle members are connected as in defendant's device:*

Obviously, and certainly, during this movement of the lower waffle member the upper waffle member can not be secured, or pivoted, to it. The two if connected together could not make the slide and the turn in the manner shown and described. The device could not then function, or operate, as shown and described in the Wright patent.

Wright, therefore, shows and describes a hinging of the upper waffle member to the main support of the whole device, independent of the lower waffle member. The two waffle members are not hinged together as in defendant's device, the device of the Capek patent and in the old waffle irons generally (Simplex and Griswold).

In Wright the pivotal connection is peculiar. As his solicitor said, when applying for the claims in suit, the claims are drawn "specific to the structure" shown. [T. R. p. 297.]

If this pivotal connection of the Wright claims be construed to mean any hinged connection of one waffle member to the other, then that is met by the prior art (Crompton and Capek, for instance), and, moreover, then would be claimed a structure totally inoperative to function as the Wright drawings and specification show and describe, and the claims would be void because drawn to a structure that could not operate as the Wright specification and drawings explain and disclose.

It is a well-recognized doctrine of patent law that, when possible, the claims of a patent should be so

construed, in view of the drawings and specification and of the prior art, as to save them. Therefore, as to construe the "pivotally connected together" of the Wright claims to mean a hinging of one waffle member direct to the other waffle member would necessitate invalidating the claims because of inoperativeness, we are forced to construe that phrase to mean substantially the pivotal connection of the upper waffle member to the support itself, independent of the lower waffle iron, and that construction, and mode of operation, and pivotal connection are not present in defendant's device, and there is no infringement.

(b) *The effect, or result, of defendant's device as to cooking waffles may be substantially the same as in the Wright device, but that is not to the point.*

For instance:

> "To make one mechanical device the equivalent of another it must appear, not only that it produces the same effect, but that such effect is produced by substantially the same mode of operation."
>
> *Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 F. R. 729, 731 (U. S. C. C. A., 9th Circ., 1918).

(c) *The casing of the Wright patent and claims performs the double function of containing, carrying and inclosing, as though laid in a box, the layers of insulating material and of resistance wire for heating,*

*and also of having the out-turned flanges of the cooking surface rest on the upper edges of the casing.*

Irrespective of the prior art, this is a different construction and mode of operation from that of defendant's device, where the insulating materials, resistance wire, etc., are not so carried *in* the casing but are attached to the bottom of the cooking surface itself, which in turn rests, as in the prior art, on the upper edges of the casing, which forms below a screen or cover. And there is a further difference. Defendant's device has a heat-insulating air space *beneath* its heating element.

In *Cummings v. Baker & Hamilton*, 144 F. R. 395, 399, the U. S. C. C. A., 9th Circ. (1906), had before it a patent for a portable forge which related to improvements in the form and arrangement of the several parts and the method of securing them together. The court recites the different constructions before it, concluding as follows:

> "And as the wind pipe of the defendant in error's forge *does not perform the double function* of the plaintiff in error's wind pipe, no infringement of his patent can be justly affirmed upon the record; for the simple reason that the defendant's forge does not contain the only new element upon which alone the plaintiff in error's patent is sustainable."

In that case, the wind pipe of the patent in suit performed a "double function," as in the patent here in

suit the casing performs a "double function." In the case above cited, one of the reasons for holding non-infringement was that in that case also, as in the case at bar, no "double function" was performed by one of the elements of the patented device.

At best Wright discloses "a mere improvement" on the prior art.

The District Court in its opinion [T. R. p. 174] states that "the claims should be narrowly construed," "in view of the prior art." As the U. S. C. C. A. (9th Circuit) said in *Eaid et al. v. Twohy Bros. Co.*, 230 F. 444, 447, U. S. C. C. A., 9th Circ. (1916), (Chock Attachment for Log Cars):

> *"Being a mere improvement on the prior art,* McConnell is only entitled to the precise devices described and claimed in his patent, and, if the devices embodied in the Chandler patent *can be* differentiated, it is clear that the charge of infringement can not be maintained. Such is the well-established law. *Kokomo Fence Machine Co. v. Kitselman,* 189 U. S. 8, 47 L. Ed. 689; *Boyd v. Janesville Hay Tool Co.,* 158 U. S. 260, 15 Sup. Ct. 837, 39 L. Ed. 973; *Railway Co. v. Sayles,* 97 U. S. 554, 24 L. Ed. 1053; *McCormick v. Talcott,* 20 How. 402, 15 L. Ed. 930."

(d) *Again, even though the ultimate result remains the same, there need be no infringement:*

> "When the changing of those positions so changes the functions of the parts that the machine acquires a substantially different mode of operation, *even though the ultimate result remains*

*the same,"* then "such change" does "avert infringement."

*Simplex Window Co. v. Hauser Reversible Window Co.,* 248 F. 919, 926 (U. S. C. C. A., 9th Circ., 1918).

This same doctrine is clearly adjudicated in *Stebler v. Porterville Citrus Assn.*, 248 F. 927, 930 (U. S. C. C. A., 9th Circ., 1918):

"While the same result is accomplished in the defendant's machine as in the complainant's, there appears to be such a *variation* of means as to avoid infringement in the features complained of. *Cimiotti Unhairing Co. v. American Fur Ref. Co.,* 198 U. S. 25, Sup. Ct. 697, 49 L. Ed. 1100."

To infringe, defendant's device must have done something more than have reached the same result. Thus says the U. S. Supreme Court in

*Burr v. Duryea,* 68 U. S. 531, 573, 17 L. Ed. 650:

"That two machines produce the same effect will not justify the assertion that they are substantially the same or that the devices used by one are therefore mere equivalents for those of the other."

Also:

*Scott et al. v. Fisher Knitting Machine Co. et al.,* 139 F. 137, 145:

"But this rule does not entitle the patentee to say that another patented machine or some ma-

chine not patented is an infringement of his patent because it produces a fabric similar to his, one that may be used for the same purpose, one that may compete with his in the market, and also fill the same 'long felt want,' unless the same elements of the one machine are used in the other and operate therein in substantially the same way to produce the result."

Even if the patent in suit were a pioneer patent, yet says the U. S. Supreme Court in

*Westinghouse v. Boyden Power Brake Co.,* 170 U. S. 569, 42 L. Ed. 1136:

"But after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than have reached the same result. * * * To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold in other language that he is entitled to patent his function."

As we have explained, there is no infringement by defendant's device when the claims of the Wright patent in suit are read in the light of the specification.

In *Henry v. City of Los Angeles,* 255 F. R. 769, U. S. C. C. A., 9th Circ. (1919), the patent before the court for consideration related to a water wheel governor. This court in that case held that:

"The long established rule of the Supreme and other Federal courts"

is one which limits

> "the scope of every patent to the invention described in the claims in it *read in the light of the specification.*"

In this case also, although both the patented device and the defendant's device were claimed to accomplish substantially the same result, that fact made no difference in the court's decision.

(e) *The prior art demonstrates non-infringement:* In view of that prior art (where other prior electrically heated cooking utensils are shown to have been constructed in substantially the same way that defendant constructs its device in the case at bar, namely, by attaching the electrical unit to the bottom of the heated surface, which surface had out-turned flanges), the claims of the patent in suit must necessarily be so construed and limited as to exclude defendant's device. Take, for instance, the feature of the outwardly extending flanges of the heated surface.

The L. F. & C. stove, the stove of the Lamb patent, and various other culinary devices of the prior art are shown to have had their outer edges or flanges extending over the edge of the casing which supports them and which acts as a screen or cover for the electrical heating and insulating elements underneath and leading in wires. Even though this were not so, it is a most obvious expedient for the mechanic skilled in the art to thus construct and relate the parts. Obviously no mechanic

would make the edge of the heating surface so non-extensive with the edges of the casing as to fall inside the casing and not to be supported on the edges of it. Equally obviously, if it was desired to prevent batter and other materials cooked on the heating surface from falling or dripping down into the casing, any mechanic, without creative invention, would extend the edge of the cooking surface to cover the edge of the casing and prevent such falling or dripping. When the material of that edge is aluminum, old in the waffle iron art, it also tends to prevent batter sticking to other metal parts, by a property inherent in the aluminum itself, when properly heated. The extended aluminum edges also aid in support, as in the prior art.

The Crompton patent shows the very extended edges, or flanges, themselves in a hinged electric cooking apparatus.

Wright shows, and claims specifically, in claims 7, 8 and 9, his flanges extended *past* the casing edges —not so in defendant's device.

As was said by the U. S. C. C. A. for the 9th Circ. in *Willamette Iron & Steel Works v. Columbia Engineering Works*, 252 F. R. 596, where the patent in suit related to a pulley provided with outwardly flaring portions to form a wide throat so that hooks or other attachments on the rope passing over the pulley could pass without danger:

> "But, passing by the question of anticipation as presented by these two patents, is there invention in giving a flare to the sides of the opening in the

> block over the sheave or wheel? It was probably found in practice that with perpendicular sides to this opening a hook or other attachment on the line passing over the sheave or wheel would catch on the one or the other of the sides of the block. If so, what was more simple than to enlarge the opening and gave the sides a flare, so that the hook or other attachment would not catch on either side, but would pass freely through the opening in the block on over the wheel? For this change in the construction of the block mechanical skill was clearly sufficient."

The application of the foregoing quotation to the case at bar is too clear to need further comment.

In *Duer v. Corbin Cabinet Lock Co.,* 149 U. S. 216; 37 L. Ed. 707, the Supreme Court had before it a patent for a furniture lock. One of the features of the lock of the patent in this case was providing a flange, or selvedge, for the lock case which would cover the routed cavity or chamber below it, the court stating (p. 222):

> "The selvedge was made wide enough to cover a cavity corresponding in depth to the projections of such keypost";

and further:

> "It certainly required no invention to make the top-plate or selvedge of the same shape so as to completely cover the cavity."

The court held the patent invalid, although the lock made under it

"gained an immediate popularity"

and

"met with large and increasing sales."

And the court makes a clear statement of the view which courts are to take of the prior art and the position of the patentee as to them, whether the patentee has actual knowledge of prior art or not, as follows (in referring to the patentee of the patent there in suit):

"He is deemed in a legal point of view to have had this and all other prior patents before him."

It is good patent law that if defendant's device is more like the prior art devices than the device of the patent in suit, in other words, reflects the prior art in clear contradistinction from the distinguishing characteristics of the patented thing, it cannot infringe the patent in suit. If we now compare defendant's device with the Crompton patent and the model thereof (the model having been prepared for argument and not introduced on the trial as the Crompton patent was only permitted to be filed after the trial) —and likewise compare defendant's device with the Lamb patent structures and the structures used by defendant, all on the one hand, and compare defendant's device with the Wright patent device and model of its drawings, very compelling conclusions must follow. The defendant's device will be found to be

in all substance in the prior art, its two-membered structure being found in Crompton, and its organization as to construction of heated or waffled surface and heating elements being found in the Landers, Frary and Clark (defendant's) and Lamb patent devices. Defendant's device *does not* follow the teaching or organization of parts of the three-membered Wright patent structure, nor the details of *exact* structure to which the trial court has found the Wright patent must be limited, that is, even assuming there was any teaching in the patent of any two-membered device. Crompton taught using the casing and other elements double or hinged together—*not* Wright.

(f) *There is no infringement in view of the file wrapper and contents of the Wright patent, a consideration of which forces upon the claims in issue limitations not included in defendant's device.*

From the history of the application of the Wright patent it appears that as originally filed his claims were directed to his idea of the combined grill and waffle iron device with its means and mechanism for operating as such. On rejection he amended and presented one claim, among others, namely claim 7, as follows:

"7. In a device of the class described, a pair of waffle members pivotally connected together and means for electrically heating each member of said pair."

This claim, with others, was rejected, and obviously it would be totally invalid in view of Simplex, to say

nothing of any other patent, or general, art. Thereafter he amended into substantially the claims of the patent, stating, at the time that the amended claims were submitted, that

"Applicant's claims are not drawn broadly but are specific to the structure."

With this understanding, the case was allowed. It seems that Wright must now be held to the understanding under which he took his claims, namely, that they were, according to his own statement, understood by him to be *"specific* to the structure." Being specific to the structure, they are not met by defendant's device, in which the parts are not *"mounted in"* the casing in the sense of the Wright patent, but in which, following old electrically heated cooking utensil construction, in the broad idea, defendant has attached his electrical unit, not to the casing, but to the bottom of the waffle iron itself.

It is evident that Wright gave up the idea of disclosing in his patent in suit two waffle irons hinged directly to each other, as in defendant's devices. The application for his patent in suit was filed February 5, 1916. On December 9, 1915, his solicitor sent a sketch [made by Wright, T. R. p. 76] of such a device to Washington to have a "search made as to the patentability of the same." [T. R. p. 215, p. 77.] That sketch is shown at T. R. p. 217. No reply seems to be produced, showing the results of that search. If it had been favorable to patentability there doubtless would have been. The fact is that after time had

elapsed for such reply Wright filed the application for the patent in suit, not showing the two waffle irons hinged directly to each other, but pivotally connected together indirectly through the frame for the purposes set forth. The claims originally filed were directed to a device having that specific kind of indirect pivotal connection, and the claims in suit, later introduced, were drawn to read on that device, were stated by Wright's attorney to be "specific to the structure," were allowed with that understanding and can not now be broadened to include differently constructed waffle irons differently connected together.

Thus in:

*Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.,* 152 U. S. 425, 14 Sup. Ct. 627, 38 L. Ed. 500:

"But the patentee having once presented his claim in that form and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claims, *or such a construction of his present claim* as would be equivalent thereto."

This was cited in *Marshall & Stearns Co. v. Murphy Mfg. Co.*, 199 F. 772, 776 (9th Circ., 1912).

To this same effect see *Kokomo Fence Machine Co. v. Kitselman,* 189 U. S. 8, 14, 49 L. Ed. 689, 693, as follows:

"Kitselman acquiesced in the rejection and withdrew his nineteenth original claim and *can not*

*now reasonably claim a construction* which would protect his machine as a pioneer field machine."

In that same Kitselman case the Supreme Court held that

"* * * *Identity of means and identity of operation* * * * *must be combined* with identity of result to constitute infringement."

Also see:

*Schultheiss Co. v. Phillips,* 264 F. R. 971, U. S. C. C. A., 9th Circ. (1920):

This case was on a patent for a soil pipe connection for closet bowls. The claims were strictly construed on the doctrine that where a patent was not obtained until after numerous rejections and amendments of claims on reference to prior patents

"the patentee is limited to the precise form and language of the claims allowed" (p. 973).

The court was of the opinion

"that complainants failed to sustain the burden resting upon them to show that the defendants to the suit infringed upon the precise form and language of the claims allowed to Bode" (p. 974).

Also, same page, the court is shown to have entertained the view that defendant was following his own earlier patent, not that of plaintiff. The appellant in the case at bar has followed its own Lamb patents and the prior art rather than the teaching of the Wright patent.

(g) *Infringement does not follow because the mere words of any of the claims of the Wright patent are applicable to defendant's device in a broad sense.*

Infringement, in the view of the Patent Law, must be something more than verbal. Thus, see Goodyear Shoe Machine Co. v. Spaulding, 101 F. 990:

> "Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant's device. *Two things are not precisely similar because the same words are applicable to each.* The question of infringement involves consideration of practical utility and of substantial identity and therefore must be quantitative as well as qualitative."

This language was quoted and approved in *Edison v. American Mutoscope Co.,* 151 F. 767, 773 (New York District).

Therefore, we respectfully submit, defendant's device should not be held to infringe the Wright patent in suit.

## FIFTH.

### If the Claims of the Wright Patent in Suit Are Construed Broadly and Are Construed So as to Include Defendant's Device, Then Those Claims Are Clearly Invalid.

In view of the prior art relating to electrically heated cooking utensils, which we have hereinabove somewhat fully reviewed and which reviewing need not

here be repeated, clearly nothing more than mechanical skill was necessary for the production of defendant's waffle iron so far as that relates to, or resembles, the Wright patent.

(a) *And this is true even if the result effected is the same or even if it is better.* To merely carry forward from the construction of the electrically heated cooking utensil of the Lamb stove patent, and other prior art devices, substantially the same means and method of construction by clamping the electrical unit by a plate to and up against the bottom of the heated cooking surface is but a mere carrying forward of the original thought, changing only form, proportions or degree. This comes within the realm of the mechanic skilled in the art and is not the result of that inventive, creative conception which has been adjudicated by the courts as a necessary adjunct to patentability.

Thus, in *Smith v. Nichols,* 88 U. S. 112, 22 L. Ed. 566, the U. S. Supreme Court had before it a patent for a woven fabric. The fabric produced under the patent seems to have been found by the court to have been better than anything in the prior art and to have been of "greater beauty and value." The court, however, held the patent invalid in view of prior art and stated (p. 119):

> "A mere carrying forward of new or more extended application of the original thought, and change only in form, proportions or degree, the

substitution of equivalents doing substantially the same thing in the same way by substantially the same means *with better results* is not such invention as will sustain a patent. These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use."

Again, we quote from the law as adjudicated by the U. S. Supreme Court as follows:

"The improvement must be of such a character that it involved invention to make it."

*Dunbar v. Meyers,* 94 U. S. 187, 24 L. Ed. 35.

And further says the court in *Dunbar v. Meyers* (p. 197):

"Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was decided by this court more than a quarter of a century ago that unless more ingenuity and skill were required in making or applying the same improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitutes the essential elements of every invention. Hotchkiss v. Greenwood, 11 How. 267."

Further says the court in the case of *Dunbar v. Meyers* (p. 199):

"Meritorious inventors are entitled to protection; but it is settled law that a mere carrying forward of an original patented conception involving only change of form, proportions or de-

gree, or the substitution of equivalents doing the same things as the original invention by substantially the same means, is not such an invention as will sustain a patent, *even though the changes of the kind may produce better results.* Smith v. Nichols, 21 Wall. 115; 22 L. Ed. 566."

When we thoughtfully weigh the prior art in the case at bar, including the Lamb and Crompton patents and the old electrically heated Simplex waffle irons hinged together and the Griswold waffle iron with aluminum surfaces, how convinced we must be that Wright took no step worthy of being dignified as invention within the authorities, including, further, the following language from section 25, Walker on Patents, Fifth Edition, as follows:

"It is not invention to produce a process, machine, manufacture, composition of matter or design which any skillful mechanic, electrician, chemist, or other expert would produce whenever required to effectuate a given result.

"In holding a patent to be void the Supreme Court, speaking by Justice Bradley, delivered a paragraph of very instructive argument in support of the rule of this section: a paragraph so valuable as to call for its verbatim quotation in this text.

" 'The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward

prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.'

"This opinion of Justice Bradley is now a classic. Many federal judges, during twenty years, have administered it as law; and some have paraphrased it in sound and suggestive lan-

guage of their own. For example, Judge Phillips has said that: 'In this day of increasing demand for new and enlarged mechanical appliances, the first natural result is the production of a large class of skilled and experienced mechanics and artisans, and, second, a more studious and constant development in applied mechanics. And, as such advance plainly points out, to the attentive and assiduous workman, the natural, larger, practical adaptation of existing, known mechanical devices; to invest each one of these developments with the immunity of a monopolizing patent, would not only be a perversion of the term "invention," but would utterly extinguish the doctrine of mechanical equivalents.' And Judge Coxe has said that a chemical patent is addressed to accomplished chemists; and 'That which seems, to the ordinary layman, to involve the exercise of extraordinary mental power, is to these men nothing but the everyday work of a laboratory routine.' And Judge Townsend has said that an electrical patent should be stripped of the dazzling halo which conventionally adorns appliances designed to deal with that mysterious agent, electricity; when a court is called on to decide the question of the presence or absence of invention, in an electrical patent."

Obviously also all of these prior art devices are clearly analogous one to the other. There is no magic in using two connected heated members for cooking waffles, so as to make a claim for invention, when such members have been used for other culinary purposes. By this token, such a patent as the British

patent to Crompton for apparatus for culinary purposes is thoroughly pertinent in discussing alleged novelty of the later Wright patent for cooking apparatus, whether it be capable of use for cooking waffles or anything else the taste and fancy and desire of the user may dictate. In this connection we quote from Potts v. Creager, 155 U. S. 597, 39 Law. Ed. 275, as follows:

> "As a result of the authorities upon this subject, it may be said that, if the new use be so nearly analogous to the former one, that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use, but if the relations between them be remote, and especially if the use of the old device produce a new result, it *may* (the court's italics) at least involve an exercise of the inventive faculty. Much, however, must still depend upon the nature of the changes required to adapt the device to its new use."

(b) *No special convenience, availability or popularity seems to have followed in the trade and art from the specific disclosures of the Wright patent in suit.*

> *Nash v. Miner,* 245 F. 349, 354, C. C. A., 7th Circ.:
>
> "no amount of convenience, availability and popularity can overcome the absence of invention. It is the province of mechanical skill to bring to invention effectiveness, which is second only in importance in the advance of science to invention itself."

(c) *The mention or substitution of aluminum in place of iron as the heated cooking surface confers no patentability.*

As we have seen, aluminum for a waffle surface was specifically old in the art prior to Wright. Being old and used for the specific purpose, all the advantages following the use of aluminum were open to the public freely, prior to the Wright patent. Changes of material with no other substantial results than those inherent with the material itself do not confer validity or patentability. Thus, in *Crown Cork & Seal Co. v. Standard Stopper Co.*, 136 F. 841, 849 (C. C. A., 2nd Circuit):

> "The two claims of the patent cover a cap having such a flange. The patentee merely employs the beaded flange of the Thompson patent of 1885. Thompson locked it in an annular groove in the neck of the bottle, while Painter locks it beneath an annular shoulder upon the bottle. It is true, Thompson contemplated using it with a *tin* vessel instead of a *glass* one, either with or without an annular groove. *It could not involve invention* to use the flange on a *glass* vessel instead of a *tin* one, or to press it into contact with an annular shoulder instead of an annular channel. It does the same work with *either material* and with either contact contrivance."

Now, when we consider the Wright patent as construed by the court, as to the claims in suit, even in the light of the Crompton patent device *alone*, we find that there remains no invention whatsoever in Wright. In

other words, if the claims in suit can be construed so as to eliminate the grill member, (to which we do not agree), they must fall because of want of invention over Crompton. The one and only distinction that can be made between the two is the use of the aluminum baking surface. There is no separate claim in the Wright patent on this feature, nor could there be. And its inclusion as a claimed element cannot impart patentability to the manifestly old residue of the claim. Griswold had aluminum baking surfaces or heated or waffled surfaces in his waffle iron, and it makes no difference patentably whether such surfact be electrically heated or dependent upon some other source of heat. This mere change of material to adopt something already known in the art cannot impart invention.

In New York Belting & P. Co. Ltd. *et al.* v. Sierer *et al.*, 149 F. 756, it was said that where stone tiling and other unyielding tiling are old in the art, and rubber tiling is also old in the art, it did not require invention to substitute for a stone tiling having a particular construction of interlocking joint a rubber tiling of similar construction.

In Marshall v. Pettingell-Andrews Co., 164 F. 862, 868, it was found that there is no invention in the substitution of paper for hard fiber, as an insulating lining for incandescent lamp sockets, the characteristics of paper being well known.

In American Acetylene Burner Co. v. Kirchberger *et al.*, 142 F. 744, 747 (decree affirmed on rehearing

147 F. 253), it was held that the use of a refractory material in lieu of metal for a burner, would not involve invention where the substitution developed *no new uses or properties in the burner itself,* and no invention was required in making the change.

A further analogous case is found in the Official Gazette of the Patent Office (123 O. G. 1000), where it was said that it amounts to only mechanical skill to provide an old electro-magnet with an old non-magnetic metal covering for the purpose of rendering the electro-magnet operative under water; and that any one having ordinary skill in the art should know that such a covering should be made of non-magnetic material to avoid interfering with electrical action of the magnet. Thus, in the case at bar, the Griswold waffle iron having taught the art that an aluminum baking surface was preferable, any one having ordinary skill in the art should know that such a surface should be used. Wright certainly was charged legally with knowledge that it *could* be used. *He* did not benefit the art with the imparting of this knowledge.

(d) *Completely anticipated if so construed, or void over prior art.*

It is incumbent upon the court to take these prior devices, such as the Crompton patent device and the Simplex and Griswold devices and examine them to determine what Wright did, if anything, over and beyond what they disclose as old. Nothing can be

found to be *new,* and the whole combination of the Wright patent claims in suit, as construed by the court, is in substance found in Crompton. And the aluminum baking surface is imported from the Griswold device to produce a complete anticipation or prior art showing in negation of invention—at least, so far as any of these claims as construed by the trial court relates to the defendant's device. There is a clearly established rule followed in the Patent Office—which, as we repeat, did not consider the Simplex, Griswold or Crompton structures—well stated by Assistant Commissioner of Patents Newton in *Ex parte* McCollum, Vol. 204 Official Gazette, p. 1346, of date of July 28, 1914, decision rendered March 27, 1914. We quote as follows, (p. 1347):

> "When legitimate combination claims, such as those appealed, are rejected on two or more references, the trend of the best authorities indicates that at least one of the references ordinarily should show the general combination claimed. This the Turcot *et al.* patent does. Then if the specific features claimed and shown by the other reference or references may be substituted without such changes as require invention and perform the function intended the two references may be legitimately combined against the claim; otherwise not."

This rule clearly would have been applied in the present case and the Crompton patent considered as the "reference" showing "the general combination claimed" had the Patent Office found it. If in-

vention results, as stated in this McCollum case, then the combining of two or more prior devices to anticipate may be objected to, that is, when *reorganization* takes place. But no *reorganization* took place in importing Griswold's aluminum baking surface, in the same art, unto the Crompton combination. Organically, the combination—casings, baking surfaces, hinges, electrical resistence, insulation and flanges overlapping the casings—was completed by Crompton. Even the *idea* of an electrical waffle iron was old in the Simplex device. But even the Crompton device could be used as a waffle iron, for there is no magic of invention in suitably shaping the waffled-surface to produce the well-known cups in the surface of the waffle itself.

When, further, we apply to this situation in this art the law as to the demarcation between invention and mere mechanical skill, as in section 25, Walker on Patents, 5th edition, quoted from *supra*, we see that Wright invented nothing when his claims in suit are construed as the court has construed them, and the basic element or grill member is omitted from the combination; and it is clear that the Patent Office would have so ruled had it discovered or cited the Crompton patent, the Simplex device and the Griswold device—or even the Crompton patent alone. Over the Crompton patent device the only essential difference was the provision of aluminum baking surfaces, old in the same art, and used for the same identical

purpose, and this no more savored of invention, we submit, than in the many cases, including those cited just above, where the quality of invention was found lacking in connection with the substitution of one material for another.

As said in American Laundry Machinery Mfg. Co. v. Troy Laundry Machinery Co. Ltd. 171 F. 870, 877, if ordinary mechanical skill is adequate to make the selection of elements from machines in the prior art and their union or combination in a new machine, operating in the old way and accomplishing the same result, *although it may be an improved result,* and no new idea is involved in the process, there is no patentable invention, however great the improvement.

In Kilbourn Knitting Machine Co. v. Liveright & Davidson, 159 F. 494, it was said that where a seamless stocking was old and lace work effect was also old, it did not involve invention to combine these features in a single article.

In Rapp v. Central Fireproof Door & Sash Co., 166 F. 430, the court said that where a fire-proof door consisting of wood incased in metal was old, and paneled metallic doors were also old, it did not involve invention to make a fire-proof door consisting of wood incased in sheet metal, both the wood and metal being paneled.

And clearly there is no *new mode of operation* in the Wright device as the court has construed the claims in suit, and this is important, for, as said in

Louden Machinery Co. v. Janesville Hay & Tool Co. *et al.,* 141 F. 975, 980, the use of a combination of old elements each acting in the old way, which has no new mode of operation, does not involve invention, although the device may have more rigidity, less friction, and better form than devices of the prior art; and the device may be ingenious and practical but it lacks invention. (In this case the factor of less friction is quite comparable to the feature concerned in the use of an aluminum baking surface which is provided to avoid sticking of the dough or batter to such surface.) The court in the latter case said that the combination is ingenious, useful, and even seems to be *without the range of mechanical skill,* but it is not patentable (*Id.* 975, 982).

(e) *No extensive use of Wright patent device:* There has been no such widespread use of the device of the Wright patent, no such extensive sales, no such displacing of other devices, no such commercial activity by the patentee or his assignees or licensees, if any, as would turn the scale in favor of validity where validity otherwise is a question of some doubt, which, we submit, can not, under the circumstances, be in this case. To this proposition reference may be made to the U. S. Supreme Court case of *Duer v. The Corbin Cabinet Lock Co.,* see *supra.*

This lack of going into actual service not only fails to help the question of validity, but it prompts the exercise of much caution in attributing to the claims

of the Wright patent anything more than is plainly shown and distinctly claimed. Thus, says the U. S. C. C. A. for the 6th Circuit, in *National Malleable Castings Co. v. Buckeye M. I. & C. Co.,* 171 F. 847:

> "The use we make of the fact that the device has never gone into actual service is in the construction or interpretation of the patent. We are justified, in view of the facts of this case, in exercising much caution in attributing to this patent anything more than is plainly shown and distinctly claimed."

The above language was quoted by the U. S. C. C. A., 9th Circ. (1919), in *Henry v. City of Los Angeles,* 255 F. 769, 780.

**Summary.**

Wherein, then, is the creative act, the inventive genius, that imparts patentable novelty to the claims in suit, read on defendant's device? What is "the slight advance made in the invention over the prior art," as the District Court puts it? [T. R. p. 174.]

It has been said that a waffle iron could thus be made of a *size* for table use. But that is a mere matter of mechanical measurement. The patent gives no direction as to size. The cases, their contents, the "flanges" may be of one size or another and still be the same elements. Nothing in the way they are combined affects size.

What is the "slight advance" of the Wright patent that confers patentability? Is it box-like casings?

They are old in Crompton. Is it such casings containing non-conducting material and heating element and roughened cooking surface? They are all in Crompton combined for the same general purpose. Is it hinging such casings together? Crompton, Capek, and Simplex hinged the parts to electrically cook between. And they had casings hinged together. Is it using aluminum? That was old for waffle irons themselves, with all the properties known. Is it a flange to rest on the casings' edges? That was old in Lamb, Crompton, Capek, Landers, Frary & Clark.

We submit no advance, however slight, is to be found that required any inventive genius to accomplish. There was no new entity capable of being defined.

The District Court says [T. R. p. 174] that "the claims should be narrowly construed and should be limited to the precise machine described."

Under such necessities what brings defendant's device within the narrow scope of the claims? That device has aluminum cooking surfaces, to be sure. But Wright, at his date, was not the original inventor or discoverer of that. It has flanges. But Wright did not invent flanges in this sort of device. They were old, as we have shown. The general combination of parts was old. Was it hinged parts? Simplex and Crompton and others already had them. Was it laying the parts all in box-like casings? Crompton had already done it, and defendant does *not* do it. The "advance," if any, in Wright must be found in

features not present in defendant's device. That device, originated independently of Wright, has its own, different construction. Not Wright, but the Lamb electric "stove" was its prototype. The cooking surface is made the part on which heating and insulating elements are mounted in both the Lamb stove and defendant's waffle iron, not casings. Let us not be misled by mere appearance. After the cooking surface, heating element and non-conducting material were fastened together in both Lamb stove and defendant's device, a screen, cover, or protecting finish is attached in both. And that is not the construction of the Wright patent, can not be any "advance" made by Wright, is not "the precise machine described" by Wright. [T. R. p. 174.] The "precise machine described" by Wright seems to have been overlooked by the Trial Judge, when he says that "the patent should not be limited to the grill member," for no machine lacking in a grill member is even suggested by Wright in describing his "precise machine." There is no other "precise machine" of which Wright teaches.

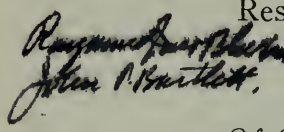
We submit there is no infringement by defendant.

There are no controlling equities in favor of the patent in suit. No trade, or market, had been built up under it, inviting defendant's entry and competition. Landers, Frary & Clark are not copyists. They are reputable manufacturers of a great line of household utilities—had been for many years. They did not copy other percolators, irons, chafing dishes, etc. True, others had been in the market, but of different type.

Landers, Frary & Clark were the first [T. R. pp. 53-55] to combine in the bases of the devices themselves the electrical equipment, replacing alcohol and the like. Defendant's waffle iron came, originating independently with them, as a natural addition to their household "lamp socket" line.

Wherefore, in view of the prior art, and the limitations of the Wright patent itself, we submit that the claims in suit should be held invalid so far as they may be said to be in defendant's device; that construed, as they must be, in view of the prior art, the claims in issue are not infringed, and that the decree of the District Court should be reversed, and the bill of complaint ordered dismissed with costs to appellant.

Respectfully submitted,



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